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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,638	11/08/2005	Andrew Gordon Williams	562492003900	7507

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MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

KELLEY, STEVEN S

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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01/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,638

Applicant(s)

WILLIAMS ET AL.

Examiner

STEVEN KELLEY

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10-8-2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10-8-2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 4-14 and 18-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 uses the phrase "may be" which is indefinite and does not positively recite that the feature "whereby authentication of a User Subscriber Identity Module is performed in the RADIUS server means".

Claims 4-14 and 18-31 are rejected as being of indefinite scope as they are multiple dependent claims that depend from multiple dependent claims.

1. Claims 4-14 and 18-31 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 4-14 and 18-31 have not been further treated on the merits.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/011467 to Jones et al (hereinafter "Jones").

Regarding claim 1, Fig. 1 of patent WO 02/011467 to Jones shows a system for use of internet authentication technology to provide UMTS authentication, the system comprising: a Serving GPRS Node (SGSN) means (27) in a UMTS network and a RADIUS server means (34). Jones further shows signaling between the SGSN means

27 and the RADIUS server means 34 (see Fig. 3, for example). As the phrase "may be" is indefinite, the feature that "whereby authentication of a User Subscriber Identity Module may be performed in the RADIUS server means" is not considered to be positively recited in claim 1. Although the claims recite "means", it is noted that for purposes of claim interpretation in this Office Action, 112 6th paragraph is not invoked since structure has been included in the limitations instead of using a means plus function format.

Regarding claim 2, Jones teaches that the SGSN means 27 is integrated with a RNC (26) within an INC (24). See for example, Fig. 1 of Jones.

Regarding claim 3, Jones teaches that the UTM network comprises a UTRAN network, see for example the Background, Detailed Description and Fig. 1 of Jones.

Claim Rejections - 35 USC § 103

2. Claims 1-3 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/011467 to Jones et al (hereinafter "Jones") in view of 2003/0051041 to Kalavade et al. (hereinafter "Kalavade").

Regarding claim 1, which recites a system for use of internet authentication technology to provide UMTS authentication, the system comprising a Serving GPRS Node (SGSN) means in a UMTS network and a RADIUS server means, Jones discloses a Serving GPRS Node (SGSN) means 27 connected to a RADIUS Server means 34. Jones further teaches "the SGSN means 27 and the RADIUS server means

34 being adapted to support signaling therebetween” as described with reference to Fig. 3, for example. Jones teaches authenticating user equipment connections in the RADIUS server means 34 for wireless access, but Jones does not disclose “whereby authentication of a User Subscriber Identity Module (USIM) may be performed in the RADIUS Server means,” as recited in claim 1. In an analogous art, Kalavade teaches authenticating roaming wireless devices with the use of a Converged Billing Gateway (CBG) server 10, where the wireless devices include a Subscriber Identity Module (SIM). Kalavade discusses the integration of RADIUS with the CBG server 10 in sections [0204] to [0213]. In section [0209] Kalavade recites “the CBG functions as a remote RADIUS server 10” and “in some cases the CBG may do the additional SIM check or the phone check to get authentication information”. In section [0213] Kalavade recites “Note that if no RADIUS server is associated with the hotspot, then the CBG can provide the complete authentication as well as functioning as the RADIUS server.” Therefore, in order to efficiently and cost effectively provide authentication functions in existing network equipment (without requiring additional authentication servers and equipment as taught in Kalavade), it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the RADIUS server means of Jones to perform authentication of USIM data within the RADIUS server means, as recited in claim 1.

Regarding claim 2, Jones teaches that the SGSN means 27 is integrated with a RNC (26) within an INC (24). See for example, Fig. 1 of Jones.

Regarding claim 3, Jones teaches that the UTMS network comprises a UTRAN network, see for example the Background, Detailed Description and Fig. 1 of Jones.

Regarding claim 15, which recites a method for use of internet authentication technology to provide UMTS authentication, the method comprising providing Serving GPRS Node (SGSN) means in a UMTS network and providing RADIUS server means, Jones discloses a Serving GPRS Node (SGSN) means 27 connected to a RADIUS Server means 34. Jones further teaches "signaling between the SGSN means 27 and the RADIUS server means 34" as described with reference to Fig. 3, for example.

Jones teaches authenticating user equipment connections in the RADIUS server means 34 for wireless access, but Jones does not disclose "that authentication of a User Subscriber Identity Module (USIM) is performed in the RADIUS Server means," as recited in claim 15. In an analogous art, Kalavade teaches authenticating roaming wireless devices with the use of a Converged Billing Gateway (CBG) server 10, where the wireless devices include a Subscriber Identity Module (SIM). Kalavade discusses the integration of RADIUS with the CBG server 10 in sections [0204] to [0213]. In section [0209] Kalavade recites "the CBG functions as a remote RADIUS server 10" and "in some cases the CBG may do the additional SIM check or the phone check to get authentication information". In section [0213] Kalavade recites "Note that if no RADIUS server is associated with the hotspot, then the CBG can provide the complete authentication as well as functioning as the RADIUS server." Therefore, in order to efficiently and cost effectively provide authentication functions in existing network equipment (without requiring additional authentication servers and equipment as taught

in Kalavade), it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the RADIUS server means of Jones to perform authentication of USIM data within the RADIUS server means, as recited in claim 15.

Regarding claim 16, Jones teaches that the SGSN means 27 is integrated with a RNC (26) within an INC (24). See for example, Fig. 1 of Jones.

Regarding claim 17, Jones teaches that the UTMS network comprises a UTRAN network, see for example the Background, Detailed Description and Fig. 1 of Jones.

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KELLEY whose telephone number is (571) 272-5652. The examiner can normally be reached on Monday-Friday, 9AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617